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Remarks

Claims 1-7, 9-16, and 18-27 remain pending in the application.

Claim Rejections - 35 U.S.C §103

The Office Action rejects claims 1 through 7, 9 through 16 and 18 through 27 as obvious over Porcher, Ski Boot, U.S. Patent 4,702,022 (Oct. 27, 1987) in view of Dalvy et al., Internal Liner for a Boot, U.S. Patent 5,924,218 (Jul. 20, 1999) in view of Mashita et al., Footwear Member, U.S. Patent 5,681,649 (Oct. 28, 1997) under the assertion that Porcher discloses all the limitations, including a liner with multiple resilient layers; that Dalvy teaches a gel pad located between the layers of an inner boot; that Mashita teaches that a gel pad of styrene and butadiene can be located in the toe box area; and that it would have been obvious to place a gel pad in the toe box area as taught by Mashita and to place a gel pad in the heel area of the liner of Porcher to aid in protection and comfort of the user's foot. With respect to the different hardnesses of the toe box and heel counter, the Office Action asserts that it would have been a mere matter of testing and optimization to find a combination of material that would provide the desired comfort and protection that would meet the desired total hardness of different areas of the boot. The combination presented by the Office Action is failing to fully consider the Applicant's claim limitations and the combination presented by the Office Action fails to disclose the Applicant's claimed invention. Therefore, withdrawal of the rejection is respectfully requested.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the

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knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaack, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The Applicant claims, *inter alia*, a boot liner comprising an outer cover 20 disposed on the outside of the upper, a first layer of resilient material 21 disposed within the outer cover, a second layer of resilient material 22 disposed within said first layer of resilient material, and an inner lining 23 disposed within said second layer of resilient material. (see Figure 2) Porcher does not disclose a boot liner with an outer cover, a first layer of resilient material, a second layer of resilient material and an inner lining as claimed by the Applicant. Porcher discloses a boot comprising a two part 1 and 2 outer shell, a single layer of resilient material (flexible walls 6a and 6b) and a vacuum chamber 5 disposed between the single layer of resilient material and the outer shell. (See Figure 3A and 3B). There is no first layer and second layer of resilient material found in Procher. There is also no outer cover in Porcher.

Mashita also fails to show a boot liner with an outer cover, a first layer of resilient material, a second layer of resilient material and an inner lining as claimed by the Applicant. (see Figures 1 - 4). Mashita merely discloses a footwear member 5. There is no disclosure in Mahita of the boot liner construction, layer types and number of layers as claimed by the Applicant.

Further, Dalvy fails to disclose a boot liner with an outer cover, a first layer of resilient material, a second layer of resilient material and an inner lining as claimed by the

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Applicant. Dalvy discloses an interior wall 12 and exterior wall 11 with liner elements disposed between them. (col. 4, lines 47 - 55 and Figure 2). A **first layer** of resilient material and a **second layer** of resilient material as claimed by the Applicant are not shown in Dalvy. Rather, Dalvy disposes elements 5 and 6 or comfort elements 13 between the interior wall 12 and exterior wall 11. (See Figure 2)

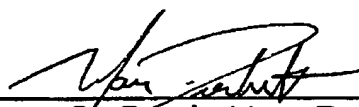
Since Porcher, Mashita and Delvy each fails to disclose at least one common limitation recited in claim 1, it follows that the combination of all three references also fails to disclose the invention recited in claim 1. As such, claim 1 and claims 2-7, 9-16 and 18-27 that depend therefrom are non-obvious and patentable over Porcher in view of Mashita and Dalvy. For at least these reasons, withdrawal of this rejection is respectfully requested.

#### Conclusion

This response has addressed all of the Examiner's grounds for rejection. The rejections based on prior art have been traversed. Reconsideration of the rejections and allowance of the claims is requested.

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By:

  
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